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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,318	10/31/2000	Elizabeth T. Whitaker	9028	9787

26890 7590 02/27/2003

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EXAMINER

FERNSTROM, KURT

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/702,318

Applicant(s)

WHITAKER ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Examiner's Affidavit*.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Siefert in view of Ziv-El. Siefert discloses in column 8, line 53 to column 9, line 21 of the specification a system and method of delivering lessons to a user over a computer comprising the steps of assessing a user's educational standing, based on the number and type of lessons previously completed, and making a lesson available to the user based on the assessment. Siefert fails to disclose that a number of lesson options are presented to the student to allow the student to choose from a list of appropriate lessons. Ziv-El discloses in column 20, lines 20-22 and in column 24, lines 9-11 a system and method of delivering lessons to a user whereby the user can access a list of available lessons based on the educational standing of the user by pressing button 163, and then selecting one of the lessons to work on. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert by providing a list of appropriate lessons from which a user may select one for the purpose of allowing the user to have greater autonomy in choosing the lesson to be received. Although icons are not explicitly

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disclosed by Siefert or Ziv-El, Official Notice is taken that icons are a widely known means of allowing a user to choose from a list of options on a computer. With respect to claim 3, Siefert discloses in column 9, line 23 to column 10, line 63 that lessons are provided based on a path taken by the student. With respect to claim 4, Siefert discloses in column 4, line 65 to column 5, line 7 that the lessons are delivered over a public-access network. With respect to claims 5 and 14, Ziv-El discloses in column 6, lines 5-6 that the network used to transmit information comprises packet switching communication protocol. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert by providing a packet switched network for the purpose of facilitating transmittal of information over the network. Both of the networks disclosed by Siefert and Ziv-El inherently comprise a plurality of displays, whereby each display can present different lessons to each user, thus reading on claim 15. With respect to claims 6 and 7, Official Notice is taken that it is well known to display "active" and "inactive" icons, where the user can initiate a sequence only by selecting an "active" icon, as for example in computer games where certain advanced scenarios are not available for selection until certain tasks are performed. Displaying icons in this manner would have been obvious to one of ordinary skill in the relevant art for the purpose of allowing the user to view unavailable as well as available lessons, to see what may be available in the future. With respect to claim 8, the disclosure of Siefert in column 9, lines 1-5 that lesson 13 is presented after lessons 1-12 have been completed amounts to a course structure file which indicates whether prerequisite courses are to be taken before presentation of a given lesson. With respect to claims 10-13, Official Notice is taken that it is well known to

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display additional icons upon achievement of certain tasks, as for example in computer games where certain advanced scenarios are not available for selection until certain tasks are performed. Official Notice is further taken that it is well known in the art to remove options for choosing lessons where the user has already demonstrated mastery of the material. While Siefert and Ziv-El do not explicitly disclose this step, such a step is inherent in a method of providing lessons. With respect to claim 14, Siefert discloses throughout the specification, as for example in column 16, lines 29-35, that the lessons may comprise video clips. The storage means for storing the lessons are disclosed in column 5, line 19 to column 6, line 20 of Siefert.

3. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert in view of Ziv-El, and further in view of Truluck. Siefert as viewed in combination with Ziv-El discloses all of the limitations of claims 16-18 with the exception of the step of refraining from making lessons available at certain predetermined times. Truluck discloses in column 4, line 55 to column 5, line 5 a method of presenting lessons over a computer whereby the computer detects certain time periods and refrains from presenting the lessons during those time periods. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Siefert as viewed in combination with Ziv-El by providing a step of refraining from making lessons available at certain predetermined times for the purpose of pacing the user properly and constructing a reasonable study plan.

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*Response to Arguments*

4. Applicant's arguments filed on November 18, 2002 have been fully considered but they are not persuasive. With respect to the limitation of identifying lessons based on the assessment; that limitation is disclosed not by Ziv El, but by Siefert. The assessment is disclosed at column 8, line 60 to column 9, line 11. See in particular lines 65-67 of column 8. Column 9, lines 4-5 disclose that a lesson is made available based on the assessment. Ziv El is cited not for this limitation, but rather the limitation of making a plurality of lessons available to a student, and allowing the student to choose a lesson to work on. However, in any teaching situation, lessons are inherently presented based on an "assessment" of the student, even if the assessment is as broad as what grade the student is in. Thus, the very fact that a student is in a certain teacher's class means that a selection of lessons offered by the teacher is made based on an assessment of the student. Even if a student is choosing the lessons, the lessons which are available for choosing are based on the assessment.

With respect to the Official Notice taken with respect to icons, icons are an extremely well known feature of computer interfaces as a means of allowing a user to choose from a variety of options. Microsoft Windows, at least as far back as 1995, has provided an "icons" option to allow a user to open a certain file by clicking on an icon. Apple Macintosh computers have had the same feature since at least 1988. Cook is provided herewith as another example of computer icons in a display. All of these cited applications are analogous to the present invention in that they allow a user to choose from a list of options. Because Ziv-El discloses a list of lessons which

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a student chooses from, in particular at column 20, lines 20-22, the provision of icons for this purpose is not patentable over the prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching of allowing from greater autonomy comes not from the combination of references, but from the Ziv-El reference. Ziv El discloses that the student is presented with a list of lessons to choose from, thus teaching that the student has greater autonomy in selecting a lesson than is disclosed by Siefert. Also, with respect to "Problem 3" at page 6 of the Response, "greater autonomy" does not mean "unlimited autonomy". Claim 1 does not teach against "greater autonomy"; claim 1 explicitly allows for greater autonomy in steps b, c and d. "Greater autonomy" is in relation to the cited excerpt of Siefert, which teaches that one lesson is made available. Ziv El discloses that a plurality of lessons is made available for choosing by the student. Similarly, with respect to "Problem 4", the "facts" and "evidence" are disclosed in Ziv-El.

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With respect to arguments presented concerning claim 3, Siefert discloses this limitation. In claim 9, lines 37-50, for example, different lessons are provided based in part on the time taken to complete a lesson, or the number of times a student fails to master the subject matter.

With respect to claims 6, 7 and 10-13, an affidavit under 37 CFR 1.104(d)(2) has been provided with this action in support of the taking of Official Notice. The function of the icons has been misconstrued by the applicant, and is more clearly described in the Affidavit. The “greyed icons” referenced in the affidavit serve the same function as the icons of the present invention, as they show scenarios which are unavailable at the moment and require certain prerequisite scenarios to be accomplished before “unlocking” and becoming available. The video games cited in the Affidavit are similar to the icons as claimed because they serve the same function of displaying to the user a list of options which can be selected along with options which are not yet available. While there are of course differences between video games and educational systems, in this respect the features are analogous.

With respect to claim 8, Siefert discloses the limitations of steps (d) and (e) with the exception of the plurality of options presented. Siefert discloses that a student profile is stored, and that certain lessons require prerequisites. As discussed above, Ziv-El discloses the presentation of a plurality of options.

With respect to the removal of lessons, Siefert inherently discloses this. After the assessment discussed at the top of column 9, Lesson 13 is presented. It is inherent that after Lesson 13 is successfully completed, Lesson 14 ( or some other lesson) is then presented. Lesson 13 is



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unavailable to the user after it has been completed. A Master's student inherently does not have available course in elementary mathematics designed for small children, particularly in a computer teaching system such as those of Ziv-El and Siefert.

With respect to claims 16-18, in response to applicant's argument that Truluck fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., prohibiting lessons to all students, in a way not alterable by the user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Nowhere does claim 16 recite that ALL students are prevented from viewing a lesson at a given time, nor does claim 16 recite that the student cannot change the times during which lessons are available. Truluck reads on the claim limitations as written.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cook discloses the use of icons as a means for allowing the user to choose from a plurality of options on a computer display.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

February 21, 2003



**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**

## **AFFIDAVIT**

I Kurt Fernstrom, do swear and affirm:

1. I am the examiner of record for U.S. Patent application, Serial # 09/702,318. This affidavit is made in support of the taking of Official Notice in the prior Office Action, Paper No. 4, at the top of page 4 in the above-referenced application. Official Notice was taken concerning limitations in claims 6 and 7 concerning the display of "inactive" icons or no icons for items that are unavailable to the user, based on personal knowledge. The basis of that knowledge is set forth below.
2. I have played two separate video games which disclose the subject matter of claims 6 and 7, in a way analogous to that of the present invention. These two games are Heroes of Might and Magic III and Mr. Driller. A discussion of each follows.

### **HEROES OF MIGHT AND MAGIC III**

3. Heroes of Might and Magic III ("Heroes") is a PC-based role-playing strategy game. It was released on March 1, 1999. (See attached "Game Rankings" document) I have played Heroes and have personal knowledge of its features.
4. Heroes has two modes: Standard, and Campaign. In the standard mode, a single scenario is presented. The player performs various tasks to complete the scenario, generally by eliminating the "enemy". The campaign mode is similar, except that each campaign comprises several scenarios, which are sequentially completed to complete the campaign.

Scoring is based on various factors, including the “game time” needed to complete each scenario.

4. Heroes comprises at least seven different campaigns. At the outset, only three are available to be played. Other campaigns are “unlocked” only when each of the first three campaigns is successfully completed.
5. On the main “Campaign” page, available scenarios are indicated by active icons, which can be activated by the player. Some other unavailable campaigns are indicated by greyed, inactive icons which do not respond to actions taken by the player. Other unavailable campaigns do not have icons.
6. When the prerequisite campaigns have been completed, newly available campaigns have active icons which start the respective campaigns when they are clicked.
7. These icons are not present during play of the game. They are present on the main Campaign page, when the player is selecting which campaign to play.

### **MR. DRILLER**

8. Mr. Driller is a video game provided on various game systems. I have played this game on the Sega Dreamcast system. Mr. Driller was released on May 11, 2000 (see “Rotten Tomatoes Reviews document). I have played Mr. Driller and have personal knowledge of its features.
9. The object of the game is to drill through various colored blocks, moving downward, without getting hit by a block or losing air. Mr. Driller has two modes: Arcade, and Time Challenge. In the Time Challenge, the player must maneuver through a board within a

certain time.

10. Mr. Driller comprises numerous different Time Challenge boards. At the outset, only a small number are available to be played. Other Time Challenge boards are “unlocked” only when each of the first Time Challenge boards is successfully completed.
11. On the main Time Challenge page, available scenarios are indicated by active icons, which can be activated by the player. Some other unavailable campaigns are indicated by greyed, inactive icons which do not respond to actions taken by the player.
12. When the prerequisite Time Challenge boards have been completed, newly available Time Challenge boards have active icons which start the respective Time Challenge boards when they are clicked.
13. These icons are not present during play of the game. They are present on the main Time Challenge page, when the player is selecting which Time Challenge board to play.

Dated: February 21, 2003



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Kurt Fernstrom